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EXAMINER	
ABEL JALIL, NEVEEN	

ART UNIT	PAPER NUMBER
2165	

NOTIFICATION DATE	DELIVERY MODE
10/14/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/781,673	SAARI ET AL.	
	Examiner	Art Unit	
	NEVEEN ABEL JALIL	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Preliminary Amendment 2/20/04*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/27/04 & 7/18/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. The preliminary amendment filed on 20-February -2004 has been received and entered.

Claims 1-24 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim(s) 1-2, 10-13 of patent # 7,216,131 B2 contain(s) every element of claim(s) 1 and 13 of the instant application and as such anticipate(s) claim(s) 1 and 13 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were

obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Objections

4. Claims 1-24 are objected to because of the following informalities:

In claims 1, 5, 9-10, 17, 22, the recitation of "in such manner" or "in such a way" suggests a relative opinion and does not constitute definitive fact. It is suggested that "in such way" is deleted or replaced with more definitive language such as "by which". Appropriate correction is required.

Dependent claims 2-12, and 14-24 should all start with the article "The" instead of "A" for consistency and accuracy.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 13-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim 13's preamble appears to be directed to a "system" however there is no indication that its in fact a computer system or that its databases claimed are anything more than software routines. A "system" implies hardware and therefore its components should be claimed as such.

Applicant's specification has offered no clear embodiment to suggest that the claimed components of the system are indeed hardware computer elements examples of which are "processor, memory, display... etc".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7, 11-19, and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Levine (U.S. Patent No. 6,385,590 B1).

As to claim 1, Levine discloses a method of creating user-experiential media services in an in\- formation system including an information content database, in which parameters descriptive of the content of information services are arranged to be stored, and a user profile database, in which parameters descriptive of users of the information services are arranged to be stored, the method:

creating a rulebase including a test user group's reaction impulses to information stimuli presented (See Figure 4, 410, 415);

creating databases descriptive of an information content space and a user profile space and including theoretical alternatives for the parameters descriptive of the content and the users of the information services (See column 2, lines 25-52);

creating a database descriptive of a reaction space including theoretical alternatives for parameters descriptive of the reactions of the users of the information services, the database being created as an interaction of the database descriptive of the information content space and the database descriptive of the user profile space, the interaction being specified based on the reaction impulses defined in the rulebase (See column 3, lines 25-45);

creating metadata files for at least one user of the information service and for at least one content of the information service by comparing the actual parameters descriptive of said user

and said content of the information service with the theoretical parameters based on said reaction impulses specified in the rulebase (See column 5, lines 12-21);

determining any possible reactions created as a result of the interaction of said user and said content of the information service based on said metadata files and the reaction impulses specified in the rulebase (See column 5, lines 1-10);

selecting the desired reaction among said possible reactions (See column 5, lines 12-21); and

in response to the user starting to browse said information service, modifying the content of said information service for presentation to the user in such a way that the probability of the creation of the desired reaction in the user is optimal (See column 3, lines 25-45).

As to claims 2, and 14, Levine discloses wherein said rulebase is created by presenting information objects, which belong to the information content space and whose content and presentation are varied, to a statistically significantly large test user group;

collecting data on the reactions of the test user group to said information objects (See column 2, lines 25-52); and

storing the reaction impulses of the test user group to the presented information objects in the rulebase by linking together the essential parameters of the user, the information content and the reaction (See column 2, lines 25-52).

As to claims 3, and 15, Levine discloses wherein said measurement data specifying the reactions of the test user group includes at *least some of* the following:

- data measured by sensors on a user's heart rate, epidermal sweating, blood pressure and/or facial muscle tension;

data determined by a camera on the user's eye movements;

data based on questionnaires, interviews or observation of behavior (See column 2, lines 25-52).

As to claims 4, and 16, Levine discloses further comprising specifying said possible reactions by combining the metadata file descriptive of the user and the metadata file descriptive of said information service;

comparing the combined metadata file with the databases descriptive of the user profile space and the information content space based on the reaction impulses included in the rulebase (See column 2, lines 25-52); and

correlating the file created as a result of said comparison to the database descriptive of the reaction space (See column 8, lines 1-8).

As to claims 5, and 17, Levine discloses further comprising creating a set of desired reactions out of the set of said possible reactions;

creating a file for each desired reaction, including linking data for the interaction between each user and each information service content object as specified by the rulebase (See column 2, lines 25-52); and

in response to the user starting to browse said information service, modifying the content of said information service for presentation to the user based on said file in such a manner that

the content of the information service to be presented to the user is derived from the desired reaction (See column 8, lines 44-67).

As to claims 6, and 18, Levine discloses further comprising collecting data during the use on the reactions of the users of the information services to the information objects presented;

updating the parameters of the information objects included in said user profile database based on the collected data (See column 8, lines 44-67, wherein it is inherent that the database is continuously modified); and

updating the linking relations of the user, information content and reaction included in the rulebase based on the collected data (See column 9, lines 19-34, wherein it is inherent that the database is continuously modified).

As to claims 7, and 19, Levine discloses wherein said data includes *at least one of* the following:

- information interest data;

- usage history data;

- measurement data specifying the users' vital functions, which further include at *least one of the* following:

- data measured by sensors on the user's heart rate, epidermal sweating, blood pressure and/or facial muscle tension;

- data on the user's eye movement, determined by a camera;

- data collected by means of questionnaires presented during usage (See column 7, lines 27-44).

As to claim 13, Levine discloses a media service information system including an information content database, in which parameters descriptive of the content of information services are arranged to be stored;

a user profile database, in which parameters descriptive of the users of information services are arranged to be stored (See corresponding rejection in claim 1 above);

a rulebase, in which the reaction impulses of a test user group to information stimuli presented are arranged to be stored (See corresponding rejection in claim 1 above);

database descriptive of an information content space and a user profile space and including theoretical alternatives for the parameters descriptive of the content of the information services (See corresponding rejection in claim 1 above);

a database descriptive of a reaction space and including theoretical alternatives for parameters descriptive of the reactions of the users of the information services, the database being created as an interaction of the database descriptive of the information content space and the database descriptive of the user profile space, the interaction being specified based on the reaction impulses defined in the rulebase (See corresponding rejection in claim 1 above);

in which media service information system metadata files are arranged to be created for at least one user of the information service and for at least one content of the information service by comparing the actual parameters descriptive of said user and said content of the information

service with the theoretical parameters based on said reaction impulses specified in the rulebase (See corresponding rejection in claim 1 above);

any possible reactions created as a result of the interaction of said user and said content of the information service are arranged to be specified based on said metadata files and the reaction impulses specified in the rule- base (See corresponding rejection in claim 1 above);

the desired reaction is arranged to be selected among said possible reactions (See corresponding rejection in claim 1 above); and

in response to the user starting to browse said information service, the content of said information service is arranged to be modified for presentation to the user in such a way that the probability of the creation of the desired reaction in the user is optimal (See corresponding rejection in claim 1 above).

Allowable Subject Matter

9. Claims 8-10 and 20-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. For complete list of relevant art, see PTO form 892.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
Primary Examiner
October 6, 2008
/Neveen Abel-Jalil/
Examiner, Art Unit 2165